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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/258,216
Filing Date	26 February 1999
First Named Inventor	SODERLUND, Hans E.
Art Unit	1634
Examiner Name	SITTON, Jehanne Souaya
Attorney Docket Number	13025-5

Total Number of Pages in This Submission

### ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Response to Missing Parts<br>under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication<br>to Technology Center (TC)<br><input type="checkbox"/> Appeal Communication to Board<br>of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please<br>Identify below):<br>Reply to a Notice of Non-Compliant<br>Amendment under 37 CFR 1.121<br>Receipt Acknowledgement Postcard |
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Remarks

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	J. David Ellett, Jr.
Signature	
Date	5 May 2004

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1634

Patent

Attorney Docket 13025-5

62616.1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Applicants: SODERLUND, Hans E. and )  
SYVANEN, Anne-Christine ) Examiner: SITTON, Jehanne Souaya  
Serial No.: 09/258,216 ) Group Art Unit: 1634  
Filed: 26 February 1999 )  
For: "Method and Reagent for Determining )  
Specific Nucleotide Variations " )

Kalow & Springut LLP  
488 Madison Avenue, 19th Floor  
New York, New York 10022

5 May 2004

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**REPLY TO A NOTICE OF NON-COMPLIANT  
AMENDMENT UNDER 37 CFR 1.121**

SIR or MADAM:

This is in reply to a notice of non-compliant amendment issued on 5 April 2004 with respect to a reply to an office action filed on 1 April 2004 with a request for continued examination (RCE) in connection with the patent application identified above. The present reply

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5 May 2004  
Date

J. David Ellett, Jr. (Reg. No. 27,875)

Applicants: Soderlund, Hans E., and Syvanen, Anne-Christine  
Filing Date: 26 February 1999  
Serial No.: 09/258,216  
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is being submitted to the Patent and Trademark Office by mail with a certificate of mailing on 5 May 2004, the day set for a reply.

In the outstanding notice of non-compliant amendment, it was asserted that the reply of 1 April 2004 failed to meet certain requirements of 37 CFR 1.121. In particular, it was asserted that the amendments to the claims in the reply of 11 March 2004 did not include a complete listing of all of the claims. The notice of non-compliant amendment required that only corrected sections of the assertedly non-compliant amendment document be resubmitted in their entirety.

The attorneys for the applicants respectfully submit that the amendments to the claims in the reply of 1 April 2004 fully complied with 37 CFR 1.121. In particular, 37 CFR 1.121(c) specifies that “[e]ach amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application.” [Underlining added.] As pointed out in the section of the reply of 1 April 2004 involving amendments to the claims of the subject application, the subject application was a continued prosecution application (CPA) which was filed on 26 September 2002. The listing of claims in the section of the reply of 1 April 2004 involving amendments to the claims was an accurate listing of all the claims of the subject continued prosecution application filed on 26 September 2002.

In a telephone conference with the undersigned attorney on 1 April 2004 in connection with a notice of non-compliant amendment issued with respect to related application 08/466,322, attorney Robert J. Spar of the Office of Patent Legal Administration of the Patent and Trademark Office indicated that, notwithstanding the language in 37 CFR 1.121(c) calling for a complete listing of all claims “in the application” and the fact that a continued prosecution application (CPA) is a separate application from the parent application on which the continued prosecution application is based, the Patent and Trademark Office expected a continued prosecution

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application and its immediate parent application to be treated as a single application for purposes of compliance with the requirements of 37 CFR 1.121(c).

Although the attorneys for the applicants maintain that the claim listing in the amendments-to-the-claims section of the reply of 1 April 2004 was fully compliant with the express wording of 37 CFR 1.121(c) and that the objections to the reply set out in the notice of non-compliant amendment of 5 April 2004 were without merit, to expedite prosecution of the subject application, an alternative amendments-to-the-claims section for the reply of 1 April 2004 is set out below which ignores the distinction between the subject continued prosecution application (CPA) filed 26 September 2002 and its immediate parent application of the same application number filed on 26 February 1999.

Authorization is hereby given to the Patent and Trademark Office to enter in the file of the subject application, at the Office's election, the alternative amendments-to-the-claims section for the reply of 1 April 2004 set out below which ignores the distinction between the subject continued prosecution application (CPA) and its immediate parent as a replacement for the amendments-to-the-claims section of the reply of 1 April 2004 as originally filed which, it is respectfully submitted, properly took account of the distinction between the subject continued prosecution application and its immediate parent.